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Conference: The Essence of IP: Scope of Protection

The Scope of IP in Germany: Current Trends

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1. Patent law

- Art 69 para 1 EPC: The extent of the protection conferred by a European patent ... shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims (= sec. 14 German Patent Act)
- UK: “Purposive *claim* construction“: what the person skilled in the art would have understood the patentee to be using the language of the claim to mean (Kirin-Amgen)
- Germany: “*patent* interpretation” (*Patentauslegung*)
 - Is required at all stages of patent examination, in opposition, invalidity and infringement proceedings
 - Is also required if the wording of the claims *seems* to be clear because the description can define words differently from ordinary language (“patent is its own dictionary”)
 - Description and drawings can support an interpretation of the claims that differs from the “mere” wording of the claims, in particular if this wording does not cover explicit examples explained or depicted in the description or the drawings
 - Do not read the claims and the description separately, but strive for a consistent understanding that brings out the invention as a meaningful whole
 - BGH 14 October 2015, X ZR 35/11, IIC 2015, 159 – Zugriffsrechte
 - BGH 12 May 2015, X ZR 43/13 – Rotorelemente

1. Patent law

BGH 15 December 2015, X ZR 30/14 – Glasfasern II concerning an alleged infringement of EP399320 “Glass fibers with increased biological compatibility”

- Claim 1: “Glass fibers ..., which have a diameter of $<8 \mu\text{m}$...”
- Allegedly infringing product contained glass fibers with a diameter of $>8 \mu\text{m}$
- Patent application read: “average/mean” diameter of $<8 \mu\text{m}$
- Belgian courts denied infringement because of this difference between application and the patent as finally granted
- But BGH:
 - Examination procedure irrelevant for patent interpretation
 - Do not compare claims but interpret the patent as granted and as a whole.
 - A patent covers all uses “according to the invention” (*erfindungsgemäß*).
 - Here: Patent extends to products, which use glass fibers with a larger diameter than $8 \mu\text{m}$ because these thicker glass fibers are not carcinogenic in the first place, and that is the problem that the invention is meant to address.

1. Patent law

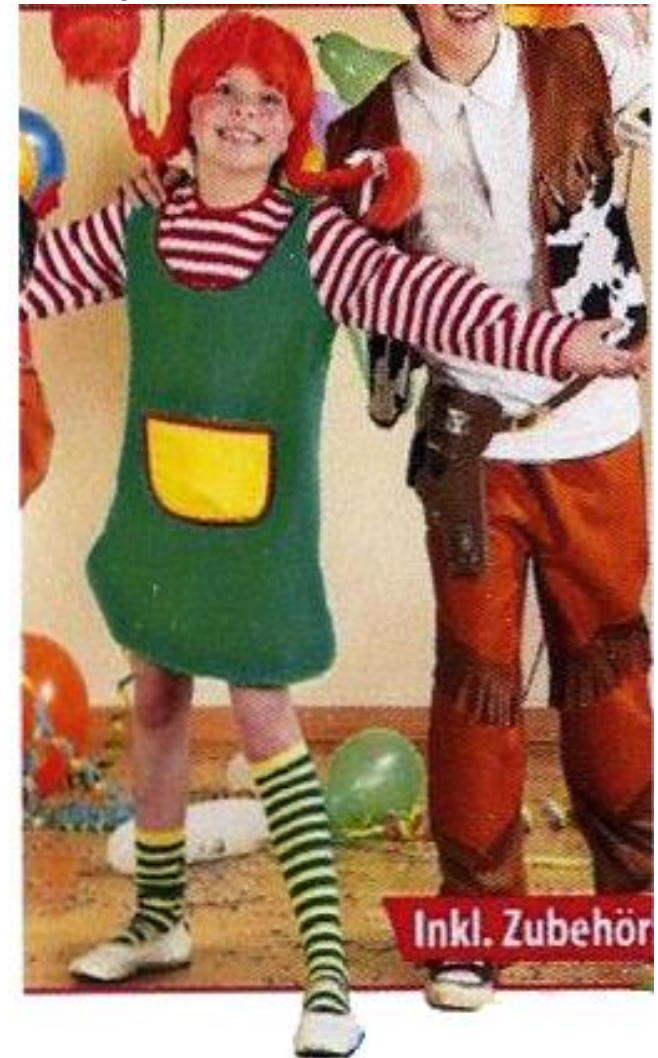
- Are claims only “a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated” (cf. art 1 s 2 prot art 69 EPC)?
- The return of the “essence of the invention“/inventive concept (cf. Kirin-Amgen para 22)?

2. Copyright law: Basics

- Unauthorized uses of the work “as is”, sec. 15 German CA
 - General exclusive right to exploit the work in any material and non-material form
 - Rights also cover cases of minor changes if overall impression of the work remains the same (e.g. different size of a picture); BGH 16 May 2013, I ZR 28/12 – Beuys-Aktion, para 37-38
- Adaptations/transformations, sec. 23 German CA
 - Adaptations or other transformations of the work may be published or exploited only with the consent of the author of the adapted or transformed work.
 - Every adaptation/transformation is at the same time a reproduction.
 - But sec. 23 applies if the original has been modified significantly (BGH Beuys-Aktion)
- The outer limit: “free uses” (*freie Benutzung*)
 - “An independent work created in the free use of the work of another person may be published or exploited without the consent of the author of the work used.” (sec. 24 German CA)
 - Comparison between the protected (elements of the) original and the new work
 - Difference supporting a finding of free use can be based on two arguments:
 - Difference in outer appearance: if the protected expression has “faded away” and the original only served as a stimulus of the new work
 - “Inner difference”: antithetical treatment, e.g. parody

2. Copyright law

- BGH 17 July 2013, I ZR 52/12, IIC 2014, 467 – Pippi Longstocking Costume I



2. Copyright law

- BGH 17 July 2013, I ZR 52/12, IIC 2014, 467 – Pippi Longstocking Costume I

verschiedene Interpretationen

Inkl. Zubehör!

Inkl. Atze-Brille!

Erwachsenen-Kostüm*
 • Mönch, mit Kreuz
 • Sträfling, mit Handschuhen
 • Pippi, mit Strumpfbünd
 • Pippi, mit Stiefeln

Stück **9.99**

Karneval-Accessoires*
 Perücken, Hüte,
 Brille oder Federboas

Stück **3.99**

2. Copyright law

BGH 17 July 2013, I ZR 52/12, IIC 2014, 467 – Pippi Longstocking Costume I

- An individual character of a novel (here: Pippi Longstocking) can enjoy copyright protection “as such” independent from the novel on condition that the author gives this character a unique personality through the combination of pronounced character traits and particular physical features.
- The transposition of a literary work into a visual work is not automatically a “free use”.
- However, a description or depiction of the outer appearance of an unique character alone will normally not be considered a prohibited reproduction or adaptation/transformation of the literary character.
- Moreover, if it is clear from the depictions in suit that the persons shown are only dressing up as the literary character for purposes of celebrating Carnival and thus merely intend to step into that role, this supports the assumption of an “inner” distance to the work and thus a free use like in cases of parodies.

2. Copyright law

BGH 19 November 2015 – I ZR 149/14 – Pippi Longstocking Costume II

- No unfair imitation (*Nachahmung*) under sec. 4 no. 9 (now no. 3) Unfair Competition Act:
 - Unfairness shall have occurred in particular where ... a person offers goods or services that are **replicas** of goods or services of a competitor if he
 - a) causes avoidable deception of the purchaser regarding their commercial origin;
 - b) unreasonably exploits or impairs the assessment of the replicated goods or services; or
 - c) dishonestly obtained the knowledge or documents needed for the replicas;
 - Costumes are not “replicas” of the literary character.
- No violation of the general clause: „Unfair commercial practices shall be illegal.“, sec. 3(1) Unfair Competition Act (*Leistungsschutz*)
 - Merchandising articles of the plaintiff are protected or at least protectable as trade marks or designs.
 - Unfair competition law does not provide a legal basis for a participation of someone who has achieved something of value in all later commercial uses of this achievement.

3. Trademark Law

BGH 23 September 2015, I ZR 105/14 – Goldbären (Haribo v Lindt)

- Plaintiff Haribo has since 1922 marketed „Haribo Gold-Bears“ (gummi candy/fruit gum)



3. Trademark Law

BGH 23 September 2015, I ZR 105/14 – Goldbären (Haribo v Lindt)

- Plaintiff Haribo is the holder of
 - German word marks **Goldbären/Goldbär (gold bears/gold bear)**, registered for bonbons made of sugar
 - Community (EU) figurative mark



3. Trademark Law

BGH 23 September 2015, I ZR 105/14 – Goldbären (Haribo v Lindt)

- In 2011, Lindt starts to market this chocolate „Teddy“



3. Trademark Law

BGH 23 September 2015, I ZR 105/14 – Goldbären

- Infringement of the word marks Goldbären/Goldbär (gold bears/gold bear)?
- Is there “similarity” between the three-dimensional design of the Lindt-Teddies and the word marks Goldbären/Goldbär so as to merit a finding of a likelihood of confusion or an unfair use of a mark with a reputation?
 - Similarity as a separate threshold question!
- In case of a collision of words and (three-dimensional) figurative designs, similarity can not follow from aural or visual similarities, but only from a conceptual similarity (similarity in meaning)
- The scope of protection of word marks must not go beyond the scope of protection that a two- or three-dimensional design can possibly offer.
- Therefore strict requirements for a finding of similarity between words and designs: A three-dimensional design designates a particular word and therefore “uses” the respective word mark only if this designation is obvious, straightforward, and exhaustive. The denomination of the design with the protected word has to suggest itself immediately to the consumer. The more descriptive or general the meaning of the word mark, the less likely is a similarity between a concrete design and this general term.
- A consumer survey showed that only 8.5% of the interviewees called the Lindt product “gold bear”, whereas a much larger portion called the product “teddy bear” or “Lindt bear”.

3. Trademark Law

BGH 23 September 2015, I ZR 105/14 – Goldbären

- Also no similarity between



and



3. Trademark Law

BGH 23 September 2015, I ZR 105/14 – Goldbären

- Finally, no unfair imitation under sec. 4 no. 9 (now no. 3) Unfair Competition Act because



is not a “replica” of



4. Concluding remarks

- The lack of references for preliminary rulings of the CJEU
 - What is a “reproduction” under art. 2 InfoSoc Directive 2001/29?
 - Is a separate threshold test of similarity proper under art. 10(2)(b)/(c) TM Directive 2015/2436 (contra *Spear & Mattel v Zynga*)?
- The correlation between the level of abstraction as regards the subject matter of protection and the scope of that protection
 - “Essence of the invention”
 - Literary characters isolated from a novel
 - Distinctive character of a trade mark